



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,774	08/04/2000	Stacy Haituka	72189/9813B	2126

33356 7590 06/01/2004

SOCAL IP LAW GROUP  
310 N. WESTLAKE BLVD. STE 120  
WESTLAKE VILLAGE, CA 91362

EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/632,774

**Applicant(s)**

HAITSUKA ET AL.

**Examiner**

Stephen Gravini

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Petrecca et al. (US 5,781,894). Petrecca is considered to disclose the claimed method comprising:

the client application activating (column 2 lines 49-56);

the client application commencing an online session with an online server, the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label (column 4 lines 1-4);

the client application causing a client window to be displayed on the output device (column 4 lines 62-67);

the client application displaying a sponsorship label on the client window, the sponsorship label comprising a hypertext link, wherein when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label (column 4 lines 6-42 wherein the disclosed activation number are considered to anticipated the claimed

sponsorship label click-through resource locator because both allow a client user to access an advertising sponsor through a method or instruction in a software product);

the client application causing a first advertisement to be displayed in the client window, wherein the client application retrieves the first advertisement from a memory cache local to the local device (column 3 lines 6-13),

the online server transmitting a second advertisement to the client application (again column 3 lines 6-13 since a plurality of advertisements are disclosed which anticipates the claimed second advertisement); and

the client application causing the second advertisement to be displayed in the client window (again column 3 lines 6-13 since a plurality of advertisements are disclosed which anticipates the claimed second advertisement). Petrecca is considered to also disclose the claimed public telephone switched network (column 4 line 5), online authorization (column 4 line 36), internet web page (column 2 line 34 wherein the disclosed network transmission implies internet web page because both perform the same function, in the same manner, with the same result), and title bar (column 2 line 53).

Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Golden et al. (US 5,761,648). Golden is considered to disclose the claimed method comprising:

a client application activating (column 4 lines 56-65);

the client application commencing an online session with the online server (column 4 lines 2-5);

the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed (column 4 lines 6-8);

the client application causing a client window to be displayed on the output device (column 4 line 60);

the client application causing a sponsorship label to be displayed on the client window, the sponsorship label comprising a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label (column 5 lines 64-67);

the client application receiving a first advertisement from a memory cache local to the local device (column 7 lines 1-67 wherein the disclosed coupon updating steps is considered to anticipate the claimed advertisement cache retrieval because both are interpreted to be incentives (advertisements and coupons) and updating implies a local memory cache retrieval must be used for the update); and

the client application causing the first advertisement to be displayed in the client window (column 8 lines 34-39). Golden is considered to also disclose the claimed second advertisement (column 5 line 45), public telephone switched network (column 1 line 12), and online authorization (column 2 lines 1-8).

Claims 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by West et al. (US 5,845,259). West is considered to disclose the claimed system comprising:

commence an online session with an online server (column 4 lines 9-25);

display a client window on an output device of the local device (column 4 lines 29-32);

obtain sponsorship data from the online server, the sponsorship data comprising a sponsorship object including a source locator associated with a sponsorship label to be displayed (column 5 lines 8-27);

display a sponsorship label on the client window, the sponsorship label comprising a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label (column 6 lines 1-4 wherein the disclosed touch screen coupon selection is considered to anticipate the claimed sponsorship label link because both provide client users access to an advertisement coupon sponsor through a resource locator-type network access);

retrieve a first advertisement from a memory cache local to the local device (column 6 lines 41-56); and

display the first advertisement in the client window (column 6 lines 56-67). West is considered to also disclose the claimed second advertisement (column 1 line 14), public telephone switched network (column 1 line 12), and online authorization (column 6 line 3 wherein the disclosed consumer invitation implies the claimed online authorization because both allow access through an online means).

Claims 15-20 are rejected under 35 U.S.C. 102(3) as being anticipated by Wendkos (US 5,983,196). Wendkos is considered to disclose the claimed system comprising:

commence an online session with an online server (column 6 lines 35-47);

obtain sponsorship data from the online server, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label (column 8 lines 28-54 wherein the disclosed source field is considered patentably equivalent to the claimed click through sponsorship label because both identify sponsorship promotion data through a resource locator-like access link point);

display a client window on an output device (column 12 lines 61-67);

display a sponsorship label on the client window, the sponsorship label comprising a hypertext link wherein the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label (column 16 lines 49-66 wherein the disclosed interactive promotional game network award is considered to anticipate the claimed sponsorship label link because both provide client users access and sponsor awards through a resource locator-type network access);

retrieve a first advertisement from a local memory cache (column 15 lines 40-53 wherein the disclosed participant instant win credit record is considered patentably equivalent to the claimed local memory first advertisement retrieval because both access data that is to be later compared for display);

display the first advertisement in the client window (column 16 lines 39-48 wherein the disclosed computer terminal interaction is considered patentably equivalent

Art Unit: 3622

to the claimed first advertisement display because both display promotional information based on a client user interaction);

obtain a second advertisement from the online server (column 15 lines 40-53 wherein the disclosed participant instant win credit record is considered patentably equivalent to the claimed online server advertisement retrieval because both access data that is to be later compared for display to an earlier retrieval from a different database); and

display the second advertisement in the client window (column 16 lines 39-48 wherein the disclosed computer terminal interaction is considered patentably equivalent to the claimed second advertisement display because both display promotional information based on a client user interaction). Wendkos is considered to also disclose the claimed public telephone switched network (column 12 line 60), online authorization (column 7 line 43 wherein the disclosed award code implies the claimed online authorization because both allow authorization through an online means), internet web page (column 6 line 46), play list display (column 6 line 37), and title bar (column 4 line 38 wherein the disclosed interactive platform anticipates the claimed title bar because both are methods of conveying a promotional incentive, such as an advertisement, to client users).

Claims 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by LaLaonde et al. (US 5,283,731). LaLaonde is considered to disclose the claimed method comprising:



the client application commencing an online session with an online server by establishing a communication channel from the local device to the online server (column 2 lines 59-66);

the client application displaying a client window on the output device of the local device (column 5 lines 4-7);

the client application causing at least one advertisement to be displayed in the client window (column 7 lines 25-30);

the user using the input device to interact with the client window and thereby access data from a web server (column 6 lines 19-25);

the client application monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction, the usage history being descriptive of the subject matter of the data that the user of the data accessed from the web server (column 6 lines 31-41);

the client application receiving an instruction from the user to terminate the online session (column 7 lines 20-22);

the client application displaying an exit window on the output device of the local device wherein the exit window includes an advertisement box associated with an exit window advertisement (column 7 lines 17-20 wherein the disclosed subsequent advertisement query implies the claimed exit window advertisement because both provide an advertisement opportunity prior to exit);

the online user identifying an exit window advertisement for display to the user based upon the usage history, wherein a subject matter of the exit window

advertisement is related to the subject matter described in the usage history (again column 7 lines 17-20 wherein the disclosed subsequent advertisement query implies the claimed exit window advertisement because both provide an advertisement opportunity prior to exit);

the online server transmitting instructions to the local device to display the exit window advertisement in the advertisement box of the exit window (column 7 lines 20-22);

the client application causing the exit window advertisement to be displayed in the advertisement box of the exit window (again column 7 lines 17-20 wherein the disclosed subsequent advertisement query implies the claimed exit window advertisement because both provide an advertisement opportunity prior to exit).

LaLaonde is considered to also disclose the claimed cancellation instruction (column 5 line 34), dial-up communication (column 8 lines 19-22), and authorization (column 5 line 33).

### ***Response to Arguments***

Applicant's arguments filed on March 24, 2004 have been fully considered but they are not persuasive. Examiner has more clearly explained how each prior art reference is considered to anticipate the claimed inventions.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically

Art Unit: 3622

pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 703 308 7570. The examiner can normally be reached on flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W Stamber can be reached on 703 305 8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMG  
5-26-2004

*Steve Gravini*